



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,685	01/04/2001	John B. Ferber	08011.3000-00000	1659
22852	7590	05/07/2007		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER BORISSOV, IGOR N	
			ART UNIT	PAPER NUMBER
			3628	
			MAIL DATE	DELIVERY MODE
			05/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/753,685	Applicant(s) FERBER, JOHN B.	
	Examiner Igor N. Borissov	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26, 28-33 and 35-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26, 28-33, 35-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/31/2007 has been entered.

Response to Amendment

Amendment received on 1/31/2007 is acknowledged and entered. Claims 27 and 34 have previously been canceled. Claims 1, 11, 17, 22 and 29 have been amended. New claims 38-47 have been added. Claims 1-26, 28-33 and 35-47 are currently pending in the application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22, 23, 25, 26, 28-30, 32, 33, 35, and 44-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chern et al. (US 6,381,465) in view of Angles et al. (US 5,933,811).

Independent Claims

Claim 22. Chern et al. (Chern) teaches a method for transmitting advertisements to a wireless device, comprising:

providing wireless device registered with a wireless advertising service (C. 8, L. 54-57);

providing advertising messages to the wireless advertising service (server) (C. 11, L. 9-20; C. 12, L. 16-19);

re-formatting advertising messages at the wireless advertising service (server) into an appropriate format corresponding to the wireless device (C. 8, L. 37-43; C. 7, L. 27-33); and

sending said advertisement messages from the wireless advertising service (server) to the wireless device (C. 11, L. 21-24),

Furthermore, Chern teaches that the user receives said messages on a subscription basis (Fig. 12, item 692), thereby suggesting paying a fee to the wireless advertisement service for the services rendered.

Chern does not specifically teach *remunerating users once the user has accepted a predetermined volume of bytes of the advertising messages*. Also, Chern does not specifically teach that *a portion of the fee paid for said advertising service goes to the user*.

Angles et al. (Angles) teaches a method for delivering customized advertisements within interactive communication environment, including: *paying a fee to an Internet provider (wireless advertising service) based on number (predetermined) of advertisements viewed* (C. 16, L. 31-33); *paying registered users for accepting advertisement messages* transmitted to registered users terminals each time the registered users view an advertisement (*predetermined number*) (C. 16, L. 35-37, 40-41), wherein said transmitted advertisement messages are based upon users profiles (C. 3, L. 19-25, 54-61), wherein *a portion of advertising revenue goes to the user as reduced access fee* (C. 4, L. 45-47), and further wherein, so as each advertisement message (electronic file) consists of a certain volume of bytes, said *number (predetermined) of advertisements viewed at (transmitted to) the user terminal indicates a predetermined volume of bytes of advertising messages*.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern to include *remunerating users for accepting the predetermined volume of bytes of advertising messages*, as suggested in Angles, because it would advantageously stimulate users to receive more advertisement messages, thereby potentially increase sales and revenue. And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern and Angles to include that *a portion of advertising revenue goes to the user*, as disclosed in Angles, because it would advantageously allow an Internet provider to reduce consumer access fees, as specifically stated in Angles (C. 4, L. 45-47).

Claim 29. Chern teaches said method for transmitting advertisements to a wireless device, comprising:

providing wireless device registered with a wireless advertising service (C. 8, L. 54-57);

re-formatting advertising messages at the wireless advertising service (server) into a format corresponding to the wireless device (C. 8, L. 37-43; C. 7, L. 27-33); and sending said advertisement message to the wireless device (C. 11, L. 21-24).

Chern does not specifically teach *remunerating users once the user has accepted a predetermined volume of bytes of the advertising messages*.

Angles teaches said method and system for delivering customized advertisements within interactive communication environment, wherein *registered users are paid for accepting advertisement messages* transmitted to registered users terminals each time the registered users view an advertisement (*predetermined number*) (C. 16, L. 35-37), wherein said transmitted advertisement messages are based upon users profiles (C. 3, L. 19-25, 54-61), and further wherein, so as each advertisement message (electronic file) consists of a certain volume of bytes, said *number (predetermined) of advertisements viewed at (transmitted to) the user terminal indicates a predetermined volume of bytes of advertising messages*.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern to include *remunerating users for accepting the predetermined volume of bytes of advertising messages*, as suggested in Angles, because it would advantageously stimulate users to receive more advertisement messages, thereby potentially increase sales and revenue.

Dependent Claims

Claims 23 and 30. Chern teaches said method, wherein said advertising messages are text messages (Fig. 16).

Claims 25 and 32. Angles teaches receiving monetary compensation for accepting the advertising messages (C. 21, L. 20-24). The motivation to combine Chern and Angles would be to stimulate users to receive more advertisement messages, thereby potentially increase sales and revenue.

Claims 26 and 33. Chern teaches said method, wherein said advertising message is a coupon (C. 1, L. 13).

Claims 28 and 35. Angles teaches that user's access charges are reduced each time the user views a customized advertisement (C. 21, L. 23-24). The motivation to combine Chern and Angles would be to stimulate users to receive more advertisement messages, thereby potentially increase sales and revenue.

Claims 44 and 46. Chern teaches said method, further comprising:
identifying a location of the registered wireless device, wherein the advertising messages are sent to the registered wireless device based upon the identified location (C. 8, L. 54-57; C. 13, L. 43-50).

Claims 45 and 47. Chern teaches said method, wherein the user is remunerated by an entity administering a wireless advertising service (see reasoning applied to claims 22 and 29).

Claims 1, 2, 5, 8-11, 13, 14, 16, 17, 21, 36, 37, and 38-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chern et al. (US 6,381,465) in view of Lee et al. (US 6,829,475) and further in view of Angles et al. (US 5,933,811).

Independent Claims

Claims 1 and 11. Chern teaches a method and system for transmitting advertisements to wireless devices, said system including an Internet provider server and advertisement server; said method comprising:

receiving user information (receiving registration information) stored in the memory of the wireless device, said information related to the user, user's preferences and the wireless device (C. 8, L. 37-41);

receiving advertising messages from advertisers (C. 11, L. 9-20; C. 12, L. 16-19);
re-formatting advertising messages at the wireless advertising service (server) into an appropriate format corresponding to the wireless device (C. 8, L. 37-43; C. 7, L. 27-33); and

sending said advertisement message to the wireless device (C. 11, L. 21-24),

While Chern does teach receiving user information including information regarding the wireless device (C. 8, L. 37-41), and thereby indicating prior registering step, Chern does not explicitly teach that said registering step includes *receiving a wireless device number that is input by a user from a website*. Also, Chern does not specifically teach *remunerating users once the user has accepted a predetermined volume of bytes of the advertising messages*.

Lee at al. (Lee) teaches a method and system for transmitting advertising messages to wireless devices, wherein prior to receiving said advertising messages, a user has to register his/her wireless device; said registering step including *logging into the Internet gateway network (indicates accessing a registration website) and inputting information about user's wireless device, including identification number, model, etc.* (C. 14, L. 1-6).

Angles teaches said method and system for delivering customized advertisements within interactive communication environment, including *paying registered users for accepting advertisement messages* transmitted to registered users terminals each time the registered users view an advertisement (*predetermined number*) (C. 16, L. 35-37), wherein said transmitted advertisement messages are based upon users profiles (C. 3, L. 19-25, 54-61), and further wherein, so as each advertisement message (electronic file) consists of a certain volume of bytes, said *number (predetermined) of advertisements viewed at (transmitted to) the user terminal indicates a predetermined volume of bytes of advertising messages.*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern to include said registering step, wherein said registering step including *receiving a wireless device number that is input by a user from a website*, as disclosed in Lee, because it would advantageously allow users to choose the desired formats and individual stations from which the user prefer to receive said messages while still being logged on to said website, as specifically stated in Lee (C. 14, L. 18-24).

And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern and Lee to include *remunerating users once the user has accepted a predetermined volume of bytes of the advertising messages*, as suggested in Angles, because it would advantageously stimulate users to receive more advertisement messages, thereby potentially increase sales and rev

Claim 17. Chern teaches said method for transmitting advertisements to wireless devices, comprising:

providing a server and database for storing the retrieved "user information", said information related to the user, user's preferences and registered wireless device (C. 8, L. 37-41; 44-45);

receiving advertising messages from advertisers over the network (C. 11, L. 9-20; C. 12, L. 16-19);

re-formatting advertising messages at the wireless advertising service (server) into an appropriate format corresponding to the wireless device (C. 8, L. 37-43; C. 7, L. 27-33);

wherein said advertisement message is based on said "user information" (C. 13, L. 43-50).

While Chern does teach receiving user information including information regarding the wireless device (C. 8, L. 37-41), and thereby indicating prior registering step, Chern does not explicitly teach that said information includes a *wireless device number*. Also, Chern does not specifically teach *remunerating users once the user has accepted a predetermined volume of bytes of the advertising messages*.

Lee teaches said method for transmitting advertising messages to wireless devices, wherein prior to receiving said advertising messages, a user has to register his wireless device; said registering step including *logging into the Internet gateway network (indicates accessing a registration website) and inputting information about wireless device, including identification number, model, etc.* (C. 14, L. 1-6).

Angles teaches said method for delivering customized advertisements within interactive communication environment, including *remunerating users once the user has accepted a predetermined number of the advertising messages* (C. 16, L. 35-37), wherein said transmitted advertisement messages are based upon users profiles (C. 3, L. 19-25, 54-61), and further wherein, so as each advertisement message (electronic file) consists of a certain volume of bytes, said *number (predetermined) of advertisements viewed at (transmitted to) the user terminal* indicates a *predetermined volume of bytes of advertising messages*.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern to include that said information includes a *wireless device number*, as disclosed in Lee, because it would advantageously allow users to associate the desired formats and individual stations from which the user prefer to receive said messages with user's wireless device, as specifically stated in Lee (C. 14, L. 18-24).

And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern and Lee to include *remunerating users once the user has accepted a predetermined volume of bytes of the advertising messages*, as suggested in Angles, because it would advantageously stimulate users to receive more advertisement messages, thereby potentially increase sales and revenue.

Dependent Claims

Claims 2 and 16. Angles teaches receiving payment from the advertisers for sending the advertising messages (C. 21, L. 20-24). The motivation to combine Chern and Lee with Angles would be to stimulate users to receive more advertisement messages, thereby potentially increase sales and revenue.

Claim 5. Angles teaches receiving monetary compensation for accepting the advertising messages (C. 21, L. 20-24). The motivation to combine Chern and Lee with Angles would be to stimulate users to receive more advertisement messages, thereby potentially increase sales and revenue.

Claim 8. Angles teaches said method and system, wherein registering the wireless devices to receive advertising messages includes providing demographic information of a user of the wireless device (C. 3, L. 19-29). The motivation to combine Chern and Lee with Angles would be to potentially increase sales and revenue by providing users with advertising closely matching users interests.

Claims 9 and 14. Lee teaches said method and system, wherein advertising messages are stored in advertising (second) database (C. 11, L. 25-28). The motivation to combine Chern with Lee would be in response to user's request to look up additional information regarding requested product (Lee; C. 28-36).

Claims 10 and 21. Angles teaches that user's access charges are reduced each time the user views a customized advertisement (C. 21, L. 23-24). The motivation to combine Chern and Lee with Angles would be to stimulate users to receive more advertisement messages, thereby potentially increase sales and revenue.

Claim 13. Lee teaches registering means (C. 14, L. 1-6). The motivation to combine Chern with Lee would be to stimulate users to receive individually tailored advertisement messages, thereby potentially increase sales and revenue.

Claims 36 and 37. Lee teaches said method and system, wherein said wireless device is a PDA (C. 7, L. 61-62); said PDA is adapted to display navigation services including maps (graphics) (C. 7, L. 15-16; C. 8, L. 9-10). The motivation to combine Chern with Lee would be to provide the user with most accurate navigation services so that the user would always have the updated information when highway changes occur (Lee; C. 8, L. 10-11).

Claims 38, 40 and 43. Chern teaches said method, further comprising: identifying a location of the registered wireless device, wherein the advertising messages are sent to the registered wireless device based upon the identified location (C. 8, L. 54-57; C. 13, L. 43-50).

Claims 39, 41 and 47. Chern teaches said method, wherein the user is remunerated by an entity administering a wireless advertising service (see reasoning applied to claims 1, 11 and 17).

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chern in view of Lee further in view of Angles and further in view of Atsmon et al. (US 6,607,136).

Dependent Claim

Claim 3. Chern, Lee and Angles teach all the limitations of claim 3, including paying the users as a bonus for accepting said advertisement messages (Angles; C. 20, L. 32-35), except specifically teaching that said remunerating includes remunerating *points* for accepting said advertisement messages.

Atsmon et al. (Atsmon) teaches a method for interacting with a broadcast media (TV or PC) to receive coupons and sales special offers, wherein users receive incentive *points* as a reward for watching advertisement (C. 55, L. 31-34).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern, Lee and Angles to include awarding the users with incentive points as a reward for watching advertisement, as disclosed in Astmon, because it would advantageously stimulate users to spend more in order to achieve a reward, thereby potentially increase sales and revenue.

Claims 4 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chern in view of Lee further in view of Angles and further in view of Maxwell (US 6,470,181).

Dependent Claims

As per claims 4 and 19, Chern, Lee and Angles teach all the limitations of Claims 4 and 19, except specifically teaching that said remunerated step includes providing additional air-time for accepting the advertising messages.

Maxwell teaches a method and system for delivery of advertising messages to cell phones, wherein an advertiser pays a portion of the airtime cost of a call originated by a mobile subscriber after that subscriber has listened to a recorded advertisement (C. 3, L. 10-12).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern, Lee and Angles to include providing additional air-time for accepting the advertising messages, as disclosed in Maxwell, because it would advantageously allow low income users, such as students, to afford long distance calls.

Claims 6, 15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chern in view of Lee further in view of Angles and further in view of Bezos et al. (US 6,029,141).

Dependent Claims

As per claims 6, 15 and 20, Chern, Lee and Angles teach all the limitations of claims 6, 15 and 20, except that users receive remuneration for *referring* an unregistered user to receive advertising messages.

Bezos et al. (Bezos) teaches a method and system for an Internet-based customer referral system, wherein registered users receive commissions for referring other users to merchant's site (C. 1, L. 62 – C. 2, L. 18).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern, Lee and Angles to include that users receive remuneration for referring an unregistered user to receive advertising messages, as disclosed in Bezos, because it would advantageously allow advertisers to expose their products to larger audience, thereby increase revenue.

Claims 7, 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chern in view of Lee further in view of Angles and further in view of Matsumoto et al. (US 6,484,946).

Dependent Claims

As per Claims 7, 12 and 18, Chern, Lee and Angles teach all the limitations of claims 7, 12 and 18, including that a user account for each registered wireless device is credited for accepting advertising messages (Angles; C. 21, L. 19-24), except specifically teaching that said user account is a *user accessible* account.

Matsumoto et al. (Matsumoto) teaches a method for accessing and displaying information related to electronic money transaction, wherein a user is able to access his account to review confidential information, including points accumulated and redeemed at participating merchants (C. 12, L. 11-18).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern, Lee and Angles to include that said user account

Art Unit: 3628

is a user *accessible* account, as disclosed in Matsumoto, because it would advantageously allow the user to avoid termination of his service for non payment.

Claim 24 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chern in view of Angles and further in view of Maxwell.

Dependent Claims

As per Claims 24 and 31, Chern and Angles teach all the limitations of Claims 24 and 31, except specifically teaching that said remunerated step includes providing additional air-time for accepting the advertising messages.

Maxwell teaches said method and system for delivery of advertising messages to cell phones, wherein an advertiser pays a portion of the airtime cost of a call originated by a mobile subscriber after that subscriber has listened to a recorded advertisement (C. 3, L. 10-12).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern and Angles to include providing additional air-time for accepting the advertising messages, as disclosed in Maxwell, because it would advantageously allow low income users, such as students, to afford long distance calls.

Response to Arguments

Applicant's arguments filed 1/31/2007 have been fully considered but they are not persuasive.

In response to applicant argument that Angles does not teach or suggest that a portion of the fee goes to a user of the registered wireless device as remuneration once the user has accepted a predetermined volume of bytes of advertising messages sent to the registered wireless device (Claim 22), it is noted that Angles teaches said method for delivering customized advertisements within interactive communication environment, including: paying a fee to an Internet provider (wireless advertising service), said paying

Art Unit: 3628

further includes allocating a portion of advertising revenue to the user as reduced access fee (C. 4, L. 45-47); and paying registered users for accepting advertisement messages transmitted to registered users terminals each time (predetermined number) the registered users view an advertisement (C. 16, L. 31-41). Furthermore, wherein, so as each advertisement message (electronic file) consists of a certain volume of bytes, *said number (predetermined) of advertisements viewed at (transmitted to) the user terminal indicates a predetermined volume of bytes of advertising messages.*

As per "predetermined number" feature per se, claim 22 does not provide any indication of the value of said predetermined number of the accepted messages. Therefore, under the broadest reasonable interpretation of the claim, Examiner understands Angles's teaching of each time the registered users view an advertisement as predetermined number of advertising messages sent to the registered wireless device.

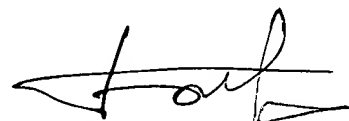
So as the remaining applicant's arguments are essentially the same as for the Claim 22, reasoning applied to Claim 22 are equally applicable to said remaining arguments.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IB
4/30//2007



IGOR N. BORISSOV
PRIMARY EXAMINER